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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,899	12/09/2003	Akemi Shoji	118030	3307

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/729,899

Applicant(s)

SHOJI ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/19/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the application filed 12/09/2003.

Claims 1-9 are currently pending in this application. Claims 1, 2, and 3 are independent claims.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 2002-370063 filed in Japan on 12/02/2002, which papers have been placed of record in the file.

Oath/Declaration

3. The Office acknowledges receipt of a properly signed Oath/Declaration submitted 10/19/2004.

Information Disclosure Statement

4. The Applicants' Information Disclosure Statement, filed 10/19/2004, has been received, entered into the record, and considered.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 3 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 3 appears to be software per se because the program itself does not include the computer readable storage medium needed to realize the computer program. Thus, the claim is a not tangibly embodied.

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. *In re Lintner*, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject

matter.”) During prosecution, applicant can amend to limit the claims to statutory subject matter.

The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf>

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(a) as being anticipated by Ueda et al. (US 2002/0057454, publication date: 05/16/2002), as cited in the Applicant's IDS, filed 10/19/2004.

As to claims 1, 2, and 3:

Ueda teaches an image processing system, method, and program comprising:

- an image editing step of carrying out editing and printing of an image (*e.g., The image editor 203b edits print image information according to the result of layout operation performed by the client system 3. In this case, the image editor 203b uses the technique in which materials are arranged and superimposed on one another without completely expanding compressed image information; see ¶ 0068 and ¶ 0145*);
- a link processing step of obtaining a desired image by linking to a WWW server that provides the image to be edited and printed in the said image editing step (*e.g., obtains desired image information from the plurality of paths in addition to image information provided from the server 2 so as to implement such an environment that can provide the layout operation to the obtained image information together with image information obtained from the server 2; see ¶ 0061 / The user edition AP204b is an application program downloaded onto the client system 3. This application program is executed by the client system 3 to implement an environment in which image information is obtained through not only the server 2 but also the plurality of paths to perform the layout operation on the same screen page with respect to the image expressed by these obtained image information; see ¶¶ 0070, 0079, 0088, and 0183*);
- a record step of tabulating the records of editing and printing processing that has been carried out by using said image editing device on the image obtained from said WWW server (*e.g., When receiving a provision request relating to the*

template and display image information via the communication controller 201, the main controller 202 sends this request to the image searcher 203a of image processor 203 ... The image searcher 203a determines whether or not the received request is a search request where the keyword is indicated (step S202). When it is the request where template number or material number is indicated (step S202: NO), the image searcher 203a determines that the received request is not the search request. When the template number is attached to the request, the image searcher 203a reads template information corresponding to this number from the template information storage 205. When the material number is added to the request, the image searcher 203a reads display image information corresponding to this number from the display image information storage 206 ... keywords showing the characteristics of material are recorded onto material numbers #1, #2, #3 ... allocated to the respective materials. FIG. 5B is an example in which keywords showing the characteristics of template are recorded onto template numbers #T1, #T2, #T3 ... allocated to the respective templates. When keywords "background" "summer" "maintain" are attached to the search request as material searching conditions, the image searcher 203a specifies material number #3 (searching result) recorded as a keyword indicating the characteristics of three conditions with reference to the table of materials illustrated in FIG. 5A. The image searcher 203a reads display image information corresponding to material number #3 from the display image information storage 206, and sends it to the main controller 202. When the conditions for searching

template are attached to the search request as searching conditions, the image searcher 203a performs the similar processing with reference to the template table of FIG. 5B; see ¶¶ 0109- 0114);

- *a step of selecting link destinations in said link processing step based on the tabulation results of said record search step; and a step of setting the link destinations in the link processing step based on these selected link destinations (e.g., a first image which represents a desired material and a second image which represents the material with data quantity different from data quantity of the first image to be linked with each other; see ¶ ¶001, 0017, 0020).*

As to claim 4:

Ueda teaches said record search device tabulates as records the users that obtained images from said WWW server (e.g., *(e.g., When receiving a provision request relating to the template and display image information via the communication controller 201, the main controller 202 sends this request to the image searcher 203a of image processor 203 ... The image searcher 203a determines whether or not the received request is a search request where the keyword is indicated (step S202). When it is the request where template number or material number is indicated (step S202: NO), the image searcher 203a determines that the received request is not the search request. When the template number is attached to the request, the image searcher 203a reads template information corresponding to this number from the template information storage 205. When the*

material number is added to the request, the image searcher 203a reads display image information corresponding to this number from the display image information storage 206 ... keywords showing the characteristics of material are recorded onto material numbers #1, #2, #3 ... allocated to the respective materials. FIG. 5B is an example in which keywords showing the characteristics of template are recorded onto template numbers #T1, #T2, #T3 ... allocated to the respective templates. When keywords "background" "summer" "maintain" are attached to the search request as material searching conditions, the image searcher 203a specifies material number #3 (searching result) recorded as a keyword indicating the characteristics of three conditions with reference to the table of materials illustrated in FIG. 5A. The image searcher 203a reads display image information corresponding to material number #3 from the display image information storage 206, and sends it to the main controller 202. When the conditions for searching template are attached to the search request as searching conditions, the image searcher 203a performs the similar processing with reference to the template table of FIG. 5B; see ¶¶ 0109- 0114), the accessed images, and the access counts, and using as a key the users who have accessed a plurality of said accessed images, search WWW servers that provide a plurality of said accessed images that have an access count higher than a predetermined value (e.g., receiving the access request from the arbitrary client ...performs user authentication processing in order to determine whether or not the operator, who operates the client system 3 as the request source, is a regular user. To that end, there is generally used such a technique that the Java applet 204a is structured in such a way to obtain the transmission of password allocated to the user registered in

advance together with the request for the layout operation and judgment is performed based on the received password. Note that the registered user name and password are stored in a predetermined storage area of the storage in advance; see ¶¶ 0103 – 0104).

As to claim 5:

Ueda teaches said record search device tabulates as records the dates and times that images were obtained from said WWW server, and using as a key the users who obtained a plurality of said accessed images on dates and times falling within a predetermined range, searches a plurality of said accessed images that have an access count higher than a predetermined value and searches WWW servers that provide a plurality of said accessed images (*e.g., The image processor 203 has an image searcher 203a, image editor 203b, image register 203c, and table T1. The image searcher 203a sends a template or display image information to the main controller according to the specified template number and material number and searches the template and display image information according to characteristic information such as a keyword with reference to table T1. ... Table 1 stores characteristic information for characterizing materials, for example, some keywords each which is provided with respect to material number uniquely allocated for each of the materials expressed by image information stored in the display image information storage 206 or print image information storage 207; see ¶0068).*

As to claim 6:

Ueda teaches a memory device that stores attribute data of said users, and said record search device, using as a key said attribute data, searches a plurality of said accessed images that have an access count higher than a predetermined value and searches WWW servers providing a plurality of said accessed images (*e.g., memory for storing a first image which represents a desired material and a second image which represents the material with data quantity different from data quantity of the first image to be linked; see ¶0013*).

As to claim 7:

Ueda teaches said record search device tabulates as a record the users who have obtained images from said WWW servers, the edited and printed images that were edited and printed by using said image editing device, and the edit and print count, and using as a key the users who printed and edited a plurality of said edited and printed images, searches a plurality of said edited and printed images having an edit and print count greater than a certain value and searches WWW servers that provide the plurality of said edited and printed images (*e.g., The image processor 203 has an image searcher 203a, image editor 203b, image register 203c, and table T1. The image searcher 203a sends a template or display image information to the main controller according to the specified template number and material number and searches the template and display image information according to characteristic information such as a keyword with reference to table T1. ... Table 1 stores characteristic information for characterizing materials, for example, some keywords each which is provided with respect to material number*

uniquely allocated for each of the materials expressed by image information stored in the display image information storage 206 or print image information storage 207; see ¶0068).

As to claim 8:

Ueda teaches said record search device tabulates as records the dates and times that editing and printing processing was carried out by using said image printing device, and using as a key the users who edited and printed a plurality of said edited and printed images on dates and times falling within a predetermined range, searches WWW servers that provide a plurality of said edited and printed images having an edit and print count that is greater than a predetermined value (*e.g., The image processor 203 has an image searcher 203a, image editor 203b, image register 203c, and table T1. The image searcher 203a sends a template or display image information to the main controller according to the specified template number and material number and searches the template and display image information according to characteristic information such as a keyword with reference to table T1. ... Table 1 stores characteristic information for characterizing materials, for example, some keywords each which is provided with respect to material number uniquely allocated for each of the materials expressed by image information stored in the display image information storage 206 or print image information storage 207; see ¶0068).*

As to claim 9:

Ueda teaches a memory device that stores the attribute data of said users, and wherein said, record search device, using as a key said attribute data, searches a plurality of said edited and printed images having an edit and print count that is greater than a predetermined value and searches WWW servers that provide a plurality of said edited and printed images (*e.g., memory for storing a first image which represents a desired material and a second image which represents the material with data quantity different from data quantity of the first image to be linked; see ¶0013*).

Conclusion

7. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

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pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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